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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,401	03/17/2004	Achim Hartlaub	82448	3701
22242 7590 08/09/2007 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER LUONG, VINH	
			ART UNIT 3682	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,401	HARTLAUB ET AL.	
	Examiner	Art Unit	
	Vinh T. Luong	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4, 6 and 9-20 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/24/07; 11/25/05; 3/17/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> . |

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 24, 2007 has been entered.
2. The restriction and election in the parent application are carried over to the instant RCE.
3. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 8, 2005.
4. The drawings were received on May 24, 2007. These drawings are not accepted by the Examiner because:

(a) The drawings are not in compliance with 37 CFR 1.84.

For example, 37 CFR 1.84(l) states “[e]very line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well defined.” However, the referential character 12 and its lead line are not uniformly thick in comparison to other referential characters 2, 4, and 11 and their lead lines; and

(b) The drawings introduce new matter. See 37 CFR 1.121(f).

The original disclosure did not describe, *inter alia*, (1) the size, shape, and configuration of the adhesive; and (2) how the adhesive is bonded to the spoke 2. For example, the adhesive might be extended partially or completely along the bottom side of the spoke as now shown in corrected FIG. 5. The adhesive also might be continuous as one piece as shown in corrected FIG. 5 or might be discrete as multiple pieces spaced apart from each other. The showing of a

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specific size, shape, and configuration of the adhesive within a full spectrum of possible sizes, shapes, and configurations of the adhesives is considered under the present disclosure to be new matter. *Cf.*, *In re Smith*, 173 U.S.P.Q. 679 (CCPA 1972) and *Ex parte George*, 230 U.S.P.Q. 575, 578 (Bd. Pat. App. & Inter. 1986).

5. The drawings were received on November 25, 2005. These drawings are not accepted by the Examiner because:

(a) The drawings are not in compliance with 37 CFR 1.84. For example, they include the following reference character(s) not mentioned in the description: 20 in FIG. 1. See 37 CFR 1.84(p)(5); and

(b) The drawings are not in compliance with 37 CFR 1.83. For example, the drawings do not show the claimed feature adhesive in Claim 3.

6. The *original* drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s), such as, the adhesive in Claim 3 must be shown *or the feature(s) canceled from the claim(s)*. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The amendment filed May 24, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the recitation "with adhesive 12" on page 5. The adhesive 12 as shown in corrected FIG. 5 introduces new matter as explained above, therefore, the amendment that refers to the adhesive 12 is new matter therewith. *Cf., In re Smith* and *Ex parte George, supra*. Applicant is required to cancel the new matter in the reply to this Office Action.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Miyako et al. (US Patent Publication 2002/0033321 A1 cited by Applicant from the Office action of Japanese Patent Office).

Miyako teaches a steering wheel 1 for mounting of a build-on part 3 (FIG. 3) thereto, the steering wheel 1 comprising:

a steering wheel skeleton 11;

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foam material 22 (FIGS. 3 and 4) surrounding the skeleton 11;

a holding part 21 that is fixed relative to the skeleton 11 by the foam material 22 so that a first portion of the holding part 21 (unnumbered at 23 in FIG. 4. See Attachment hereinafter "Att.") is fixed within the foam material 22 against removal therefrom and a second portion 21b (FIG. 4) of the holding part 21 projects therefrom for mounting of the build-on part 3 thereto,

wherein the first portion holding part (Att.) surrounds the steering wheel skeleton 11 at least partially at one point (see point P in FIG. 4 of Att.).

The Examiner respectfully submits that Miyako's first and second portions of the holding part 21 are one-piece formed as shown in FIG. 4. Therefore, Miyako's first and second portions have a common area along the line 10 in FIG. 4. The periphery of this common area define the point(s) that at least *partially* surround(s) the skeleton 11. Therefore, Claim 5 is anticipated by Miyako's second embodiment, i.e., FIGS. 3 and 4.

9. Claims 3, 4, 6, and 9-20 are allowed.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

11. Applicant's arguments filed May 24, 2007 have been fully considered but they are not persuasive.

DRAWINGS

Applicant stated "annotated Figure 5 now specifically shows the adhesive that may be present between the holding part 11 and the spoke 2."

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As noted above, the specific showing of a size, shape, and configuration of the adhesive within a full spectrum of possible sizes, shapes, and configurations of the adhesives is considered under the present disclosure to be new matter. Further, 35 USC 113 states that "[d]rawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim." See also 37 CFR 1.81(d). Therefor, the replacement drawings have been disapproved.

ART REJECTION

With respect to Claim 5, Applicant contended that Miyako et al. do not disclose or suggest the recited holding part first portion that is fixed within the foam material and surrounds the steering wheel at least partially at one point.

The Examiner respectfully submits during patent examination, the pending claims must be given their *broadest reasonable interpretation consistent with the specification*, however, it is impermissible to import the subject matter from the specification into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) *en banc* and MPEP 2111.

In the instant case, the Examiner respectfully submits that Miyako's first and second portions of the holding part 21 have a common area along the line 10 in FIG. 4. The periphery of this common area (at P in FIG. 4 of Att.) at least *partially* surrounds the top surface of skeleton 11. Therefore, Claim 5 is anticipated by Miyako.

For the foregoing, Applicant's request to put the application in condition for allowance is respectfully declined.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

August 3, 2007

A handwritten signature in black ink, appearing to read 'Vinh T. Luong', with a long horizontal line extending to the right.

Vinh T. Luong
Primary Examiner

ATTACHMENT



